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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

IN RE: Patent Application)
Serial No. 09/458,998)
FILED: December 10, 1999) GROUP ART UNIT: 1643
TITLE: EIA FOR MONITORING)
LEGIONELLA PNEUMOPHILA)
PRESENCE IN WATER)
SAMPLES) EXAMINER: Ja-Na Hines
APPLICANTS: Norman James Moore)
Myron David Whipkey)
James William Welch)

PETITION PURSUANT TO 37 C.F.R. 1.181 FOR
REVERSAL OF EXAMINER'S NOTICE OF ABANDONMENT
MAILED MARCH 28, 2005 AND FOR DECLARATION THAT NO
ABANDONMENT HAS OCCURRED

Applicants and their assignee, Binax, Inc. ("Petitioners") hereby petition pursuant to 37 C.F.R. 1.181 (c), invoking the supervisory authority of the Commissioner to reverse the "Notice of Abandonment" herein mailed March 28, 2005 (Exhibit A hereto). In addition, Petitioners seek a declarative ruling that this application has at all times since its filing been properly pending before this Office and the fixing of a firm schedule for (i) the Examiner's response to the Rewritten Appeal Brief filed March 23, 2004 (ii) any further briefs permitted to be filed and (iii) transmission to the Board of Appeals and Interferences (hereinafter "Board") of all briefs. This firm schedule is necessary to alleviate, insofar as possible, the severe prejudice to Petitioners resulting from the delay between March 23, 2004 and the present time,

during which no activity in any way helpful to advancing the progress of Petitioners' application took place and all activity that did occur- namely, issuance of the June 10, 2004 and March 28, 2005 Notices(Exhibits C and A, respectively)- has been detrimental to such progress, in both instances through no fault on Petitioners' part or that of their counsel.

A check to cover the Petition Fee of \$400 accompanies this petition.

I. FACTS

1. Appealed Claims 10-35 were first asserted in this application on November 1, 2001 in response to an Office Action mailed August 1, 2001 which finally rejected claims 1-9. This response was accompanied by a request for continued examination with a check for the small entity fee of \$370.00 and a check to cover a small entity extra claim fee of \$54.00.

2. The ensuing Office Action mailed January 16, 2002 entered the new claims and rejected all of them on multiple grounds.

3. Petitioners initially responded to the January 16, 2002 rejection on May 16, 2002 but were required in a paper mailed June 7, 2002 to resubmit this response on the ground that it was "non-compliant" for failing to include a marked-up *typed* copy¹ of the amended claims. A resubmitted response was filed July 8, 2002. In the response, originally and as resubmitted, some of the claims were amended in response to the action, but claims 12-14, 22,24,28 and 29 were maintained exactly as originally asserted.

4. A further Office action was mailed October 11, 2002 rejecting all of Claims 10-35

¹ The marked up copy submitted on May 16, 2002 was marked up in handwriting on a background of typed claims.

and reasserting rejections already made in the earlier action, albeit in part under new labels.

5. Having due regard to (a) 35 U.S.C. §134 (a), which states that “An applicant for a patent, *any* of whose claims has been twice rejected, may appeal...to the Board of Patent Appeals and Interferences...” (Emphasis added) and (b) 37 C.F.R. 1.191 (a), which at that time, in pertinent portion, then permitted such an appeal by “Every applicant for a patent, any of whose claims has been twice or finally...rejected”, petitioners elected to appeal from the October 11, 2002 rejection. The Notice of Appeal with a check for the \$160.00 small entity appeal fee and a Request for three-month time extension (from the January 11, 2003 due date for response to April 11, 2003) with a check for the small entity 3-month time extension fee of \$465.00 were accordingly filed on April 11, 2003.

6. On October 14, 2003 (the first business day following Saturday, October 11, 2003) Petitioners filed a Brief on Appeal in 3 copies, a check for the small entity appeal brief fee of \$165.00, a request for a 4-month extension of time to file the brief and a check for the small entity 3-month time extension fee of \$740.00.

7. Subsequently, petitioners' counsel received from the Examiner a “Notification of Non-Compliance with 37 C.F.R. 1.192 (c)” mailed January 23, 2004, copy of which is appended as Exhibit B. This notification requires the filing of a new brief in triplicate within the longest of three specified time periods, all said to be extensible under 37 C.F.R. 1.136, and specifies in its numbered box 9 the particular reasons for the requirement.

8. On March 23, 2004 petitioners' counsel filed the Rewritten Brief on Appeal in 3 copies, a request for one-month time extension, a check for \$55.00 to cover the small-entity one month time extension fee and in view of an intervening publication she had read, which

encouraged such filings in applications under appeal to the Board, she also filed a new drawing that had been required in the Office action from which appeal was taken, with a cover paper so identifying the drawing and the reason for filing it.² In preparing the Rewritten Brief, Petitioners' counsel gave particular attention to the comments in Exhibit B relating to, and (to a degree) interpreting, certain of the requirements of 37 C.F.R. 1.192 (c), and a conscientious effort to comply with these requirements, as so interpreted, was made.

9. In early June, petitioner's counsel received from the Examiner a second "Notice of non-Compliance with 37 C.F.R. 1.192 (c)", mailed June 10, 2004, copy of which is Exhibit C hereto. This second "Notice" for the *first* time alleges that the Notice of Appeal is defective, and assigns this as the *reason* for Exhibit C's holding that the Rewritten Brief on Appeal filed March 23, 2004 is "defective". In Box 9, in its first sentence relating specifically to the alleged unacceptability of the Notice of Appeal, it says this is "because there has been no second or final rejection in this patent application". It then quotes from 37 C.F.R.1.191 (a) as this rule then read, but in its final sentence states "However, the instant claims in this patent application have not been finally rejected."

10. Within less than a week, on June 16, 2004, Petitioners' counsel filed a "Response" to this notice, copy of which is Exhibit D, pointing out, *inter alia*, that Claims 10-35, albeit not *finally rejected*, *were twice rejected*, so that applicants clearly had a right to appeal from the Office Action of October 11, 2002.

² Counsel had previously been accustomed to the practice mode whereby items required by the Examiner in an action appealed from were simply held in abeyance until the completion of the appeal if they were not germane to the appeal, as the replacement of an informal drawing with a formal drawing is not.

11. More than 9 months later, and *more than one year after the Rewritten Brief on Appeal was filed*, the Examiner on March 28, 2005 forwarded the "Notice of Abandonment", Exhibit A hereto, which *mischaracterizes* the initial Brief on Appeal filed October 14, 2003 and the Rewritten Brief filed March 23, 2004 as merely "*a reply*" to the office action of October 11, 2002 and holds the patent application abandoned for "failure to timely file a proper reply to the Office letter mailed on 11 October 2002", inviting attention to 37 C.F.R. 1.85 (a)³ and 1.111⁴ and adding "(See explanation in box 7 below)".

Box 7 of the Notice makes no explanation at all but says, *beneath* the Supervisory Patent Examiner's signature, "Petitions to revive under 37 C.F.R. 1.137 (a) or (b) or requests to withdraw the holding of abandonment under 37 C.F.R. 1.181, should be promptly

³ 37 C.F.R. 1.85 (a) relating to "Corrections to Drawings" was in fact satisfied by petitioners' March 23, 2004 filing of the paper captioned "Compliance with Drawing Requirement" and its attached new formal drawing prepared by a U.S. Patent and Trademark Office-approved draftsman which corrects the deficiencies of the informal drawing filed with the patent application. These deficiencies were noted in a Form PTOL948 attached to the *first* office action of February 13, 2001. That action at p. 2, ¶ 1 required a new drawing to replace the informal one. The requirement was subsequently held in abeyance at petitioners' request in the final rejection of August 1, 2001 (p. 2, ¶2) and in the action of January 16, 2002 (p.2, ¶2), but the period of abeyance was terminated in the October 11, 2002 action from which appeal was taken (p. 2, ¶2). The latter action inaccurately implies a need to submit "corrections" to the drawing for Examiner approval before filing the new one, but the only criticisms of record deal with nonuniformity of lines and indistinctness of numbers in the informal drawing originally submitted. The new formal drawing submitted March 23, 2004 is free of these problems and is otherwise identical to the original informal drawing.

⁴ While Exhibit B identifies an alleged deficiency of the original Brief under 37 C.F.R. 1.192, it does not refer to 37 C.F.R. 1.111 and neither does Exhibit C. Exhibit A's reference to 37 C.F.R. 1.111 makes *no* explanation or identification as to the nature of any alleged deficiency under this rule in the arguments contained in the original Brief on Appeal which counter such new grounds of rejection as the October 11, 2002 office action presented. These same arguments are *all* repeated in the Rewritten Brief on Appeal and again, Exhibit C refers to none of them.

filed to minimize any negative effects on patent term”.

II. ARGUMENT

It is extremely difficult to arrive at a reasonable interpretation of the actions pursued in Exhibits A, B, and C hereto by the Examiner and Supervisory Examiner with respect to the present application. Applicant's counsel, who has practiced before the U.S. Patent and Trademark Office for almost 45 years and was herself a patent examiner for approximately five years preceding that (during which she, in 1957, received a US Department of Commerce award for outstanding performance), has pondered these inexplicable activities at length, over and over again, and is at a loss to arrive at a logically satisfactory explanation.

If the Examiner and Supervisory Examiner believed that applicants were *not entitled* under the patent statute and the rules to appeal to the Board of Appeals and Interferences after the second rejection of Claims 10-35, *why* did they not raise this point immediately after the Notice of Appeal was filed on April 11, 2003, *two years* ago, instead of awaiting the filing of the appeal brief and then *requiring* the filing of a second, *new* rewritten brief on appeal and *then* delaying the present, wholly inexplicable holding of abandonment of the application for more than a year? These actions on their part are extremely prejudicial to petitioners because of the inexorable loss of time, the expense of preparing and filing two briefs, and the angst that has arisen from the manifest lack of communication concerning what is really at the root of the unprecedented manner in which this application is being treated.

A. One Remotely Possible Explanation of Exhibit A

One can conjecture that the tacit message being conveyed *might be* a suggestion that

Claims 10-35, rejected *first* in the January 16, 2002 office action, (which was responded to on May 16, 2002 and in the resubmitted amendment of July 8, 2002 with amendments to claims 10, 11, 15-20, 21, 23, 25-27 and 30-35 that were designed to meet specific rejections in the action) and then all again rejected on October 11, 2003 must either

- a) be rejected twice in *amended form* to meet the criterion of 37 C.F.R. 1.191 (a) (as it appeared prior to September 13, 2004) and that of 35 U.S.C. 134 (a),
- b) or if not, must be *finally* rejected, in order for an appeal to be properly made to the Board.

If this rationale is being pursued *sub silentio*, it is an *improper* rationale, which it appears that the Examiner and Supervisory Examiner *know* and hence have refrained from setting forth in plain words. It is improper, because if the rule, 37 C.F.R. 1.191 (a), as it appeared before September 13, 2004, meant this, its own words would convey precisely this meaning clearly. Moreover, if that rule were to be amended to clearly convey this meaning, it would have been *irreconcilable* with the statute, 35 U.S.C. §134 (a), which plainly says:

“An applicant for a patent, *any of whose claims has been twice rejected*, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal” (Emphasis supplied)⁵

Any possible argument that 37 C.F.R. 1.191 (a) as formerly written, could have the

⁵ Petitioners note that those claims numbered between 10 and 35 and *not* specifically mentioned in text as having been amended in response to the “final” rejection of August 2, 2001 have *never* been amended, were clearly *twice rejected* and would justify the appeal taken on April 11, 2003 under the words of 35 U.S.C. §134 (a) *even if* there were a way that the rule, 37 C.F.R. 1.191 (a) as formerly written, *could legitimately* be construed as Petitioners’ attorney now conjectures that the Examiner and Supervisory Examiner *may* tacitly be attempting to construe it.

meaning postulated above is dispelled by the *present* version of the rule adopted as final on September 13, 2004 which says that "Appeals to the Board...*under 35 U.S.C. 134 (a)* ...are conducted according to part 41 ..."of 37 C.F.R. (Emphasis added) and thus emphasize the *identical* meaning of 37 USC 1.191 (a) and 35 USC 134 (a).

B. Another Possible Explanation of Exhibit A

Exhibit A's unusual lumping together of the original Brief on Appeal filed October 14, 2003 and the Rewritten Brief on Appeal filed March 23, 2004 (and necessitated by Exhibit B) and Exhibit A's assertion of abandonment of the application for "failure to timely file a proper reply to the Office letter mailed on October 11, 2002" suggests the possibility that some still unidentified portion of the Office action of October 11, 2002 is tacitly regarded by the Examiner and Supervisory Examiner as not having been responded to by arguments presented in either the original or the rewritten brief. *If* that is the case, however, the Examiner and /or Supervisory Examiner clearly had a responsibility not only to petitioners but to the Board, to bring up whatever was deemed to be the unanswered portion of the October 11, 2002 action in the *first* "Notification of Non-Compliance with 37 C.F.R. 1.192 (c)" dispatched on January 23, 2004, Exhibit B hereto.

Neither the petitioners here (consisting of applicants and their assignee) nor their counsel, are mind readers--and nothing in any pertinent statute or rule requires them to be. If the Examiner or the Supervisory Examiner, or both, perceived a rejection advanced in the October 11, 2002 office action from which appeal was taken that was not acknowledged and responded to by argument in the original appeal brief filed on October 14, 2003, they had a

duty and responsibility, singly and together, to call it to petitioners' and their counsel's attention *in Exhibit B* in clear and readily understandable language, so that it could be dealt with in the Rewritten Brief that Exhibit B required.

Moreover, the Examiner and Supervisory Examiner, if tasked with reviewing the Brief on Appeal for the Board, had the same duty and responsibility to the Board, in making their review, of calling *all* perceived defects in the original brief to the attention of petitioners and their counsel in order to insure the completeness of the Rewritten Brief.

Failing that duty and responsibility, they instead issued another "Notification of Non-compliance with 37 C.F.R. 1.192 (c) on June 10, 2004, attacking the sufficiency of the Notice of Appeal and saying that it rendered the March 23, 2004 Rewritten Brief "defective". But a simple "Notice of Appeal" from the rejection of claims cannot render a separate, later filed paper, such as a brief, "defective" and the further assertion of Exhibit C that "there has been no second or final rejection in this patent application" is clearly wrong because all claims in the application--i.e., claims 10-35, *were rejected twice*, on January 16, 2002 and again on October 11, 2002 and hence the April 11, 2003 Notice of Appeal was wholly proper under 37 C.F.R. 1.191 (a), as it then read *and as it now reads and* under 35 U.S.C. 134 (a) as well.

If it is the Examiner's and Supervisory Examiner's as yet *undisclosed* position that an alleged failure of petitioners and their counsel to address some *as yet unidentified* aspect of the October 11, 2002 office action in both the Appeal brief filed October 14, 2003 and the new, Rewritten Appeal Brief filed March 23, 2004 which they required, there can be *no possible justification* for the issuance of Exhibit A, or its somewhat bizarre holding that this application has been abandoned for failure to respond adequately and "timely" to the October 11, 2002

action.

The very idea, suggested by the ruling, that an Examiner and/or a Supervisory Examiner *might* employ such a “bait and switch” tactic in requiring patent applicant members of the public to file a Rewritten Appeal Brief in order to correct *one* defect of inadvertent omission, while themselves withholding the existence of another alleged but equally correctable defect, and then use the latter alleged defect as a *sub silentio* ground for suddenly holding the involved patent application abandoned, is an abhorrent one. It is also contrary to the focus of the controlling statute and the governing rules, both of which are geared toward holding patent applications abandoned *only* under clearly defined and readily comprehensible circumstances, *with all of the facts clearly on the table*.

Petitioners hasten to add that they intend no accusation of, and cast no aspersion on, the Examiner and Supervisory Examiner here beyond what is clear and unarguable –i.e. that the saga of the treatment of this application in the notices that are Exhibits A, B and C is wholly incomprehensible– leading to the conclusion that the holding of abandonment in Exhibit A is not explainable on the face of the record and should be reversed forthwith.

C. Petitioners Have Not Abandoned This Application

Throughout the pendency of this application, petitioners have taken *no action* contrary to the controlling rules and/or the patent statute. They have zealously met every deadline in this application, albeit at times availing of their right under 37 C.F.R. 1.136(a) to extend certain deadlines by filing a request for time extension and paying a fee established by the rules.

They have at no time done anything indicative of an intention to abandon this application, and they have had no such intention during any of the relevant period.

While it is understood that an application can be held abandoned for egregious, clearly deliberate, misfeasance by an applicant in responding to rejections or other requirements in an office action, no allegations of such conduct are made in any of Exhibits A, B, and C and petitioners are confident that the application file clearly shows an absence of such conduct.

Under these circumstances, reversal of the holding of abandonment in Exhibit A is required by the letter and spirit of the controlling statute and rules.

CONCLUSION

Petitioner hereby requests that supervisory authority be exercised in favor of granting the relief herein sought.

Respectfully submitted,

A handwritten signature in cursive script that reads "Mary Helen Sears". The signature is written in dark ink and is positioned above the printed name and contact information.

Mary Helen Sears, Reg. 19,961

Attorney for Petitioners

M.H. Sears Law Firm Chartered

910 Seventeenth Street, NW, Suite 800

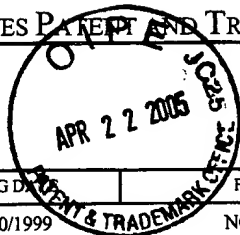
Washington, D.C. 20006

Telephone: (202) 463-3892

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UNITED STATES PATENT AND TRADEMARK OFFICE



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/458,998	12/10/1999	NORMAN JAMES MOORE		9562

7590

03/28/2005

MARY HELEN SEARS
THE M H SEARS LAW FIRM CHARTERED
910 SEVENTEENTH STREET NW SUITE 800
WASHINGTON, DC 20006

EXAMINER

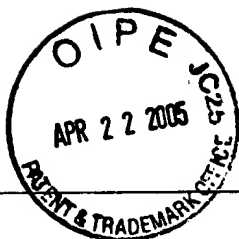
HINES, JANA A

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



Notice of Abandonment

Application No.

09/458,998

Examiner

Ja-Na Hines

Applicant(s)

MOORE ET AL.

Art Unit

1645

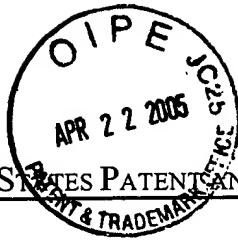
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This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 11 October 2002.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☒ A reply was received on 10/14/03 and 3/23/04 but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☐ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

L. F. Smith
LYNETTE R. F. SMITH
SUPERVISORY PATENT
TECHNOLOGY CLERK

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.



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7590 01/23/2004

MARY HELEN SEARS
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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

APR 22 2005

**Notification of Non-Compliance
With 37 CFR 1.192(c)**

Application No.

09/458,998

Applicant(s)

MOORE ET AL.

Examiner

Ja-Na Hines

Art Unit

1645

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

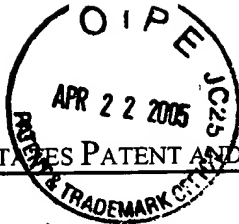
The Appeal Brief filed on 14 October 2003 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192(c) within the longest of any of the following three **TIME PERIODS**: (1) **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer; (2) **TWO MONTHS** from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. **EXTENSIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☐ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☐ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☐ A single ground of rejection has been applied to two or more claims in this application, and
 - (a) ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
 - (b) ☐ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

The brief omits a positive statement as required by 37 CFR 1.192(c) 7 that the claims do not stand and fall together. Additionally, the brief does not present arguments that explain why the claims of each group are believed to be separately patentable. Merely stating that the claims are separately patentable is not sufficient when the standard required is to state why the claims are separately patentable.

[Handwritten Signature]
SUPERVISORY EXAMINER



UNITED STATES PATENT AND TRADEMARK OFFICE

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7590 06/10/2004

MARY HELEN SEARS
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WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notification of Non-Compliance
With 37 CFR 1.192(c)**

Application No.

09/458,998

Applicant(s)

MOORE ET AL.

Examiner

Ja-Na Hines

Art Unit

1645

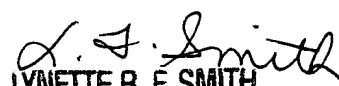
--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on March 23, 2004 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192(c) within the longest of any of the following three **TIME PERIODS**: (1) **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer; (2) **TWO MONTHS** from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. **EXTENSIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☐ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☐ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☐ A single ground of rejection has been applied to two or more claims in this application, and
 - (a) ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
 - (b) ☐ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

The notice of appeal filed on March 23, 2004 is not acceptable under 37 CFR 1.191(a) because there has been no second or final rejection in this patent application. Every applicant for a patent or for reissue of a patent, and every owner of a patent under ex parte reexamination filed under § 1.510 for a patent that issued from an original application filed in the United States before November 29, 1999, any of whose claims has been twice or finally (§ 1.113) rejected, may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in § 1.17(b) within the time period provided under §§ 1.134 and 1.136 for reply. However, the instant claims in this patent application have not been finally rejected.


LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

IN RE: Patent Application)
Serial No. 09/458,998)
FILED: December 10, 1999) GROUP ART UNIT: 1643
TITLE: EIA FOR MONITORING)
LEGIONELLA PNEUMOPHILA)
PRESENCE IN WATER)
SAMPLES) EXAMINER: Ja-Na Hines
APPLICANTS: Norman James Moore)
Myron David Whipkey)
James William Welch)

RESPONSE TO NOTIFICATION OF
NON-COMPLIANCE WITH 37 C.F.R. 1.192 (c)
MAILED JUNE 10, 2004 AND REQUEST FOR
REINSTATEMENT OF APPEAL

Applicants' counsel has carefully examined the retained file of the above-identified application.

This file shows that in response to the final rejection of Claims 1-9 mailed August 1, 2001, Applicants filed new claims 10-35, canceled claims 1-9, submitted an argument responding to the final rejection and filed a Request for Continued Examination.

A first rejection of claims 10-35 was mailed January 16, 2002 to which Applicants

171014x / 09458998. RESPONSE TO NOTIFICATION of NONCOMPLIANCE

responded on July 8, 2002. A *second* rejection of claims 10-35 was mailed October 11, 2002, in response to which Applicants filed an appeal on April 11, 2003:

37 C.F.R. 1.191(a) decrees that

“Every applicant for a patent..., any of whose claims has been *twice or finally* (§1.13) *rejected*, may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in §1.17(b) within the time period provided under §§ 1.134 and 1.136 for reply.” (Emphasis added)

Upon consideration of the *second* rejection of claims 10-35 mailed Oct. 11, 2002, Applicants elected to appeal and on April 11, 2003 filed a notice of appeal with check for \$160.00 (the small entity appeal fee then in force) plus a request for 3-month extension of time to respond with check for \$465.00 (the small entity 3-month extension fee at that time).

The notice mailed June 10, 2004 asserts that “there has been no second or final rejection in this patent application” in its first sentence but in its last sentence states that “the instant claims in this patent application have not been finally rejected”. In *fact*, while it is true that claims 10-35, the only claims in the case, have not been *finally* rejected, they *have been twice rejected*--i.e. on January 16, 2002 and again on October 11, 2003. 37 C.F.R. §1.191 (a) clearly leaves it to the Applicants to elect appeal whenever *any* claim has been “*twice or finally*” rejected.

Restoration of this application to appealed status and transmission of the appeal brief to the Board of Patent Appeals and Interferences are hence respectfully requested.

Applicants note that they have *no objection* to the Examiner’s reconsideration of this application or to any other constructive input by the Examiner, including but not limited to the

formulation of an Examiner's Answer to the Appeal Brief, and that this Request for Reinstatement of Appeal is filed *only* to ensure that:

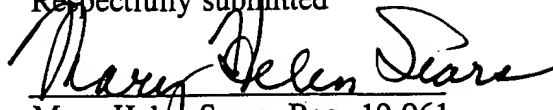
- (a) the appeal process overall and the legitimacy of the appeal brief are not in any way clouded by the inapposite "Notification of Non Compliance with 37 C.F.R. §1.192(c)" which has been placed in the file and
- (b) the interjection of this inapposite "Notification of Non-compliance" does not in any way interfere with the progress of the appeal, (assuming that the Examiner does not undertake to withdraw all of the rejections of record upon reconsideration of this application and thereby obviate the appeal.)

Applicants point out that:

1. The appeal was properly filed, in strict compliance with 37 C.F.R. §1.191 (a) as detailed above.
2. While it is perfectly proper, as Applicants understand the rules, for the Examiner to give further consideration to the application at any stage of the appeal process, and Applicants have no objection to that, it is *not proper*, nor countenanced by any rule or statute known to Applicants' counsel to hold an *appeal brief* non-compliant with 37 C.F.R. §1.192(c) because of a postulated, but wholly unsupportable and inaccurately arrived at, lack of compliance with 37 C.F.R. §1.191(a).

Applicants accordingly request withdrawal of the "Notice of Non-Compliance with §37 C.F.R. §1.192 (c)", restoration of the Appeal Brief to compliant status vis-a-vis 37 C.F.R. §1.192 (c) and withdrawal of the inaccurate holding, or *at least* implication, that the appeal was taken prematurely, and hence contrary to 37 C.F.R. 1.191 (a).

Respectfully submitted

A handwritten signature in cursive script, reading "Mary Helen Sears". The signature is written in dark ink and is positioned above the printed name.

Mary Helen Sears, Reg. 19,961

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